

UNITED STATES DISTRICT COURT
DISTRICT OF MASSACHUSETTS

LOUIS M. GERSON COMPANY, INC.

Plaintiff,

v.

3M COMPANY,

Defendant.

Civil Action No. 04-12389 (MLW)

**DECLARATION OF FRANK E. SCHERKENBACH IN SUPPORT OF 3M COMPANY'S
MOTION TO DISMISS AMENDED COMPLAINT FOR LACK OF SUBJECT MATTER
JURISDICTION UNDER RULE 12(b)(1)**

I, Frank E. Scherkenbach, declare and state as follows:

1. I am an attorney with the law firm of Fish & Richardson P.C., counsel of record for 3M Company ("3M") in the above-referenced action. If called upon to testify, I could and would competently testify as to each of the below stated facts, unless stated otherwise.

2. I am lead counsel for 3M Company in this case.

3. On November 22, 2004, I spoke with Mr. Robert Kann, counsel for Louis M. Gerson Company, Inc. ("Gerson"), about Gerson's original complaint identifying the '441 patent. I offered to provide Gerson with a covenant not to sue on behalf of 3M and said that, if the covenant was not acceptable to Gerson, 3M would be moving to dismiss the complaint for lack of jurisdiction based on the covenant. Mr. Kann agreed to consider the covenant. He emailed me later that day and asked to see 3M's draft memorandum in support of the covenant as well, allegedly "to give full consideration to 3M's proposal and for plaintiff Gerson to determine its position."

4. Later that same day, November 22, I sent Mr. Kann both 3M's proposed '411 Covenant and 3M's draft supporting memorandum.

5. Before Noon the following day, November 23, Mr. Kann filed Gerson's amended complaint adding 14 new patents, sent me an email attaching a copy of that complaint, and

formally indicated the obvious -- that Gerson did not accept the '411 Covenant and would not dismiss its case.

6. Therefore, on November 29, I asked Mr. Kann (by email) to provide the basis for Gerson's amended complaint and sought a meet and confer to avoid, hopefully, a second motion to dismiss. We ultimately arranged to speak about these issues on December 3.

7. During our December 3 conversation, I inquired about the basis for Gerson's apprehension of suit. Mr. Kann said that Gerson customers (whom he would not name) had received threats from 3M employees (whom he would not name) regarding "3M paint patents." Mr. Kann indicated that he would not provide the names to me because the people involved were allegedly fearful of retribution of some sort.

8. Mr. Kann also agreed during the December 3 conversation to reconsider a covenant on all the patents like the one 3M had filed on the '441 patent. I subsequently provided such a covenant to Mr. Kann later that same day.

9. On December 6, Mr. Kann provided a redlined covenant that (among other things) sought to extend the covenant to future Gerson products. Mr. Kann also indicated that Gerson would not dismiss its case on the 15 patents with prejudice; instead, Gerson would agree only to a dismissal without prejudice.

10. Attached as Exhibit A is a memorandum of law filed by Gerson in the District of Minnesota entitled "Defendant's Memorandum of Law in Support of its Motion to Dismiss, Stay or Transfer this Action Pursuant to the First-To-File Rule."

11. Attached as Exhibit B is a printout from the Patent and Trademark Office website showing that U.S. patent 4,936,511 has been abandoned for failure to pay maintenance fees.

I declare under penalty of perjury under the laws of the Commonwealth of Massachusetts that the foregoing is true and correct.

Executed this 20th day of December at Boston, Massachusetts.

/s/Frank E. Scherkenbach
Frank E. Scherkenbach (BBO #653819)
Fish & Richardson P.C.
225 Franklin Street
Boston, MA 02110-2804
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CERTIFICATE OF SERVICE

I hereby certify that a true copy of the foregoing DECLARATION OF FRANK E. SCHERKENBACH IN SUPPORT OF 3M COMPANY'S MOTION TO DISMISS AMENDED COMPLAINT FOR LACK OF SUBJECT MATTER JURISDICTION UNDER RULE 12(b)(1) was served on counsel for Plaintiff via e-filing and regular mail on Robert L. Kann, Bromberg & Sunstein LLP, 125 Summer Street, Boston, MA 02110 on this 20th day of December, 2004.

/s/ Kathleen J. Tobin
Kathleen J. Tobin

Declaration of Frank E. Scherkenbach iso Motion to Dismiss.doc